



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 38005-0164

Applicant: Volkmar WEHNER et al.

Patent No.: 6,794,517 B2

Serial No.: 10/092,889

Issue Date: September 21, 2004

Filing Date: March 8, 2002

Examiner: S. Wright

Title: BIS(TRIFLUOROMETHYL)HYDANTOINS AS INTERMEDIATES
FROM PHARMACEUTICALLY ACTIVE INGREDIENTS

**REQUEST FOR CERTIFICATE OF CORRECTION
PURSUANT TO 37 C.F.R. § 1.322**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Certificate
NOV 12 2004
of Correction

Applicants hereby request a Certificate of Correction, pursuant to 37 C.F.R. §1.322, to correct errors that are present in the patent, incurred through the fault of the Patent and Trademark Office ("PTO"). Attached is Form PTO/SB/44, which reflects the changes listed below:

Column 18, line 27, delete "X s" and insert --X is--

Column 18, line 32, delete "COOH a metal s it of COOH," and insert -COOH, a metal salt of COOH,--

Column 18, line 37, after "wherein" delete "the"

Column 18, line 52, delete "X," and insert --X',--.

The following item is evidence that the errors were incurred through the part of the Applicant and the PTO:

- A copy of the Examiner's Amendment that accompanied the Notice of Allowance mailed May 13, 2004.

The required filing fee under §1.20(a) is enclosed. Applicants believe the appropriate filing fee is enclosed, however, the Commissioner is hereby authorized to charge any deficiency or to credit any overpayment to Deposit Account No. 08-1641.

Please send the Certificate of Correction to:

Heller Ehrman White & McAuliffe, LLP
1666 K Street, N.W., Suite 300
Washington, DC 20006

Applicant requests a print copy of the correction cover page to Patent No. 6,794,517.

Respectfully submitted,

Date: November 9, 2004

Patricia D. Granados
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Reg. No. 33,614
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Washington, DC 20006
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24 NOV 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO : 6,794,517 *B2*

DATED : September 21, 2004

INVENTOR(S) : Volkmar WEHNER et al.

It is certified that error appears in the above-identified patent and that said Letters Patent are hereby corrected as shown below:

Column 18, line 27, delete "X s" and insert --X is--

Column 18, line 32, delete "COOH a metal s it of COOH," and insert --COOH, a metal salt of COOH,--

Column 18, line 37, after "wherein" delete "the"

Column 18, line 52, delete "X," and insert --X',--

MAILING ADDRESS OF SENDER: Heller Ehrman White & McAuliffe

PATENT NO. 6,794,517 *B2*

1666 K Street, N.W., Suite 300

No ~~en~~  anal copies

Washington, D.C. 20006

24 NOV 2004

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Paul M. Booth on May 10, 2004.

The application has been amended as follows:

Please amend the claims as shown on the following pages:

Claims 1-6 (Canceled).

7. (currently amended) The hydantoin of claim 16, wherein R¹ is (C₁-C₆)-alkyl, (C₃-C₇)-cycloalkyl or (C₃-C₇)-cycloalkyl-(C₁-C₄)-alkyl.

8. (previously presented) The hydantoin of claim 7, wherein R¹ is isobutyl or cyclopropylmethyl.

9. (original) The hydantoin of claim 7, wherein the carbon atom carrying the R¹ residue has an S configuration.

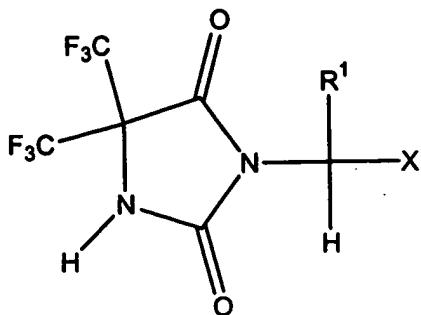
10. (currently amended) The hydantoin of claim 16, wherein the carboxylic acid derivative X is a (C₁-C₆)-alkyl carboxylate ester.

Claims 11-12 (Canceled).

13. (currently amended) The process of claim 22, wherein the reaction is carried out in an inert solvent and at a temperature from about 20°C to about 80°C.

Claims 14-15 (Canceled).

16. (New) A hydantoin having the formula:

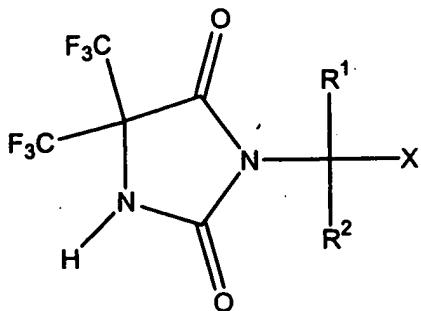


in any stereoisomeric or tautomeric form,

wherein R¹ is hydrogen or an unsubstituted or substituted residue selected from the group consisting of (C₁-C₆)-alkyl, (C₂-C₆)-alkenyl, (C₂-C₆)-alkynyl, (C₃-C₇)-cycloalkyl, (C₃-C₇)-cycloalkyl-(C₁-C₄)-alkyl, (C₆-C₁₂)-aryl, (C₆-C₁₂)-aryl-(C₁-C₄)-alkyl, heteroaryl and heteroaryl-(C₁-C₄)-alkyl,

wherein X is COOH, a metal salt of COOH, an ammonium salt of COOH, a C₁-C₆ alkyl carboxylate ester, a benzyl carboxylate ester, -CONH₂, -CN, -CHO, or -CH₂OH or a salt or derivative thereof, wherein said derivative is an ester, an amide, a nitrile, an aldehyde or a hydroxymethyl group.

17. (New) A hydantoin having the formula:



wherein R¹ and R² independently are selected from the group consisting of hydrogen or an unsubstituted or substituted residue selected from the group consisting of (C₁-C₆)-alkyl, (C₂-C₆)-alkenyl, (C₂-C₆)-alkynyl, (C₃-C₇)-cycloalkyl, (C₃-C₇)-cycloalkyl-(C₁-C₄)-alkyl, (C₆-C₁₂)-aryl, (C₆-C₁₂)-aryl-(C₁-C₄)-alkyl, heteroaryl and heteroaryl-(C₁-C₄)-alkyl,

wherein X is COOH, a metal salt of COOH, an ammonium salt of COOH, a C₁-C₆ alkyl carboxylate ester, a benzyl carboxylate ester, -CONH₂, -CN, -CHO, or -CH₂OH or a salt or derivative thereof, wherein said derivative is an ester, an amide, a nitrile, an aldehyde or a hydroxymethyl group.

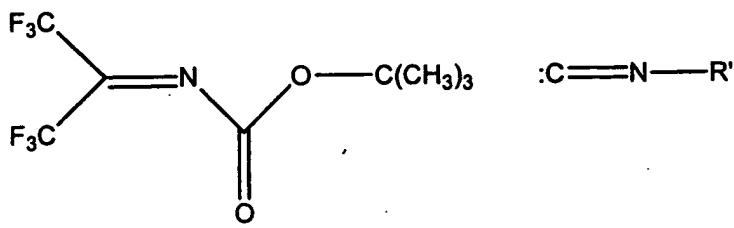
18. (New) The hydantoin according to claim 16, wherein X is COOH, or a salt thereof a metal salt of COOH, or an ammonium salt of COOH.

19. (New) The hydantoin according to claim 17, wherein X is COOH or a salt thereof a metal salt of COOH, or an ammonium salt of COOH.

20. (New) The hydantoin according to claim 16, wherein X is an ester or an amide, a C₁-C₆ alkyl carboxylate ester, a benzyl carboxylate ester, or -CONH₂.

21. (New) The hydantoin according to claim 17, wherein X is an ester or an amide a C₁-C₆ alkyl carboxylate ester, a benzyl carboxylate ester, or -CONH₂.

22. (New) A process for preparing a hydantoin according to claim 17, which comprises reacting the compound of formula II with a compound of formula III



wherein R' is $-C(R^1)(R^2)-X'$,

wherein R¹ and R² independently are selected from the group consisting of hydrogen or an unsubstituted or substituted residue selected from the group consisting of (C₁-C₆)-alkyl, (C₂-C₆)-alkenyl, (C₂-C₆)-alkynyl, (C₃-C₇)-cycloalkyl, (C₃-C₇)-cycloalkyl-(C₁-C₄)-alkyl, (C₆-C₁₂)-aryl, (C₆-C₁₂)-aryl-(C₁-C₄)-alkyl, heteroaryl and heteroaryl-(C₁-C₄)-alkyl, and

wherein X' is selected from the group consisting of a carboxylic acid ester, an amide, a nitrile, an aldehyde and a hydroxymethyl group, a C₁-C₆ alkyl carboxylate ester, a benzyl carboxylate ester, -CONH₂, -CN, -CHO, or -CH₂OH.

23. (new) The hydantoin of claim 17, wherein the carboxylic acid derivative X is a (C₁-C₆)-alkyl carboxylate ester.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FREE TRANSMITTAL for FY 2005

Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 100.00)

Complete if Known

Application Number	10/092,889 now 6,794,517
Filing Date	March 8, 2002
First Named Inventor	Volkmar WEINER et al.
Examiner Name	S. Wright
Art Unit	1626
Attorney Docket No.	38005-0164

METHOD OF PAYMENT (check one)

 Check Credit card Money Order Other None
 Deposit Account

Deposit Account Number 08-1641 (Docket No. 38005-0164)

Deposit Account Name Heller Ehrman White & McAuliffe LLP

The Commissioner is authorized to: (check all that apply)

Charge fee(s) indicated below Credit any overpayments
 Charge any additional fee(s) during the pendency of this application
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	430	2252	215	Extension for reply within second month	
1253	980	2253	490	Extension for reply within third month	
1254	1,530	2254	765	Extension for reply within fourth month	
1255	2,080	2255	1,040	Extension for reply within fifth month	
1401	340	2401	170	Notice of Appeal	
1402	340	2402	170	Filing a brief in support of an appeal	
1403	300	2403	150	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,370	2453	685	Petition to revive - unintentional	
1501	1,370	2501	685	Utility issue fee (or reissue)	
1502	490	2502	245	Design issue fee	
1503	660	2503	330	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify) Certificate of Correction					100
* Reduced by Basic Filing Fee Paid					SUBTOTAL (3) (\$100)

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)	Patricia D. Granados	Registration No. (Attorney/Agent)	33,683	Telephone	202-912-2000
Signature	<i>Patricia D. Granados</i>	Date	November 9, 2004	Customer No.	26633